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APR 06 2005

OFFICE OF PETITIONS

In re Application of
Kevin B. Kline
Application No. 10/783,502
Filed: February 20, 2004
Attorney Docket No. P00799-US-01
(20680.0001)

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:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(b)
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This decision is in response to the petition under 37 CFR 1.47(a) filed July 13, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed February 20, 2004 without an executed oath or declaration. Accordingly, on May 13, 2004, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration.

In response, on July 13, 2004, the present petition was filed, accompanied by the late filing surcharge. Applicant seeks status under 37 CFR 1.47(b) because it is asserted that 1) the instant application is the nationalization of PCT/US/27056 filed August 23, 2002, 2) the instant application is identical to the PCT application, 3) the inventor refused to sign the request to allow the applicant to proceed without his signature under PCT Rule 4.15(b) and in accordance with 37 CFR 1.425 and 4) by decision dated September 5, 2003, the Petition under 37 CFR 1.425 filed June 25, 2003 was granted.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (2).

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The "UTILITY PATENT APPLICATION TRANSMITTAL" filed on February 20, 2004 indicated that the application was a filing of a new nonprovisional application under 37 CFR 1.53(b). The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 111(a). Note that the letter has the statement "(Only for new nonprovisional applications under 37 CFR 1.53(b))." The filing under 37 CFR 1.53(b) is only directed to application filed under 35 U.S.C. 111(a). The first page of the specification indicated that the application was a naturalization and claim benefit of the PCT Application PCT/US02/27056. This is not considered a clear instruction to treat the application as a national stage application of the PCT Application. Thus the application was properly treated by OIPE as a filing under 35 U.S.C. 111(a). Even if applicant had given instruction to file a national stage application, the application would have been treated as a 111(a) application since applicant the transmittal letter would have been considered as a conflicting instructions and the papers would have been right fully considered as having been filed under 35 U.S.C. 111(a).

The application is deemed to have been filed under 35 U.S.C. 111(a).

CONTINUATION APPLICATION

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/783,502) and the international application (PCT/US02/27056)

designating the United States were copending on February 20, 2004. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is an continuation of international application PCT/US02/27056, filed August 23, 2002, which designated the United States and is now abandoned."

An oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. The oath or declaration submitted with the instant petition is not executed by the sole inventor or the assignee.

A declaration in compliance with 37 CFR 1.63, 1.64, and 1.67 must be presented, signed by all of the signing inventors, if any. If no inventor(s) will sign the declaration, the declaration may be signed on behalf of the inventor by an assignee. The oath or declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration. If the oath or declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.¹

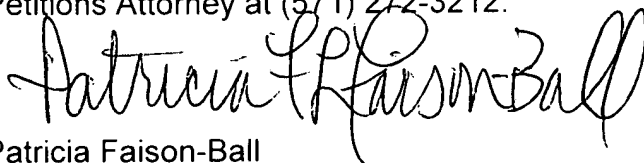
A petition fee in the amount of \$130.00 has been charged to deposit account no. 09-0007.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

¹MPEP 409.03(b).